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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/825,585	04/01/1997	TAKEHIRO YOSHIDA	35.C10516-CO	1146

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EXAMINER	
ENG, GEORGE	
ART UNIT	PAPER NUMBER
2643	14

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/825,585	Applicant(s) YOSHIDA, TAKEHIRO	
	Examiner George Eng	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 11-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 11-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2003 (paper no. 53) has been entered.

Response to Amendment

2. This office action is in response to amendment filed 10/3/2003 (paper no. 50).

Claim Rejections - 35 USC § 112

3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 6, the term "any" render the claims vague and indefinite because it has an alternate meaning, which does not positively identify the claimed limitations.

Claims 2-5 are also rejected because of depending on claim 1 containing the same deficiency.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-6 and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueno (US PAT. 5,661,568) in view of Kinoshita et al. (US PAT. 5,216,517 hereinafter Kinoshita).

Regarding claim 1, Ueno discloses a data communication apparatus, i.e., a modem, adapted to execute a plurality kinds of facsimile protocol in which the transmission speeds are different from each other (col. 4 lines 38-49) comprising a detection circuit for detecting a call signal, i.e., ID information for identifying a communication apparatus, at a calling station before start of communication with the communication apparatus (col. 4 lines 51-57), a communication circuit (111) adapted to communicate with the calling station using one of the plurality kinds of facsimile protocols (col. 4 lines 50-57 and col. 5 lines 43-52), a memory (105) for storing communication information (col. 5 lines 6-17), a control circuit for reading the communication information in order to select one of the first and second communications protocols (col. 5 lines 30-57). Ueno differs from the claimed invention in not specifically teaching to store ID information detected by the detector circuit and a facsimile protocol used for communication with the calling station conducted through the communication circuit in order to start a facsimile

protocol stored in a memory at a called station corresponding to the ID information detected by the detector circuit after having made a response to the call. However, Kinoshita teaches a communication terminal apparatus capable of automatically selecting different communication protocols in correspondence with a caller identification information in order to make more flexible and efficient utilization of the communication terminal apparatus (col. 14 line 45 through col. 17 line 16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ueno in storing the protocol in associated with the ID information of the calling station so that the control circuit adapted to start the facsimile protocol corresponding to the ID information detected by the detector circuit is stored in the memory, as per teaching of Kinoshita, because it makes more flexible and efficient utilization of the communication terminal apparatus.

Regarding claims 2-3, Kinoshita discloses a registration circuit (64, figure 5) for registering the ID information of a calling station and the communication protocol in accordance with an instruction from a user, wherein the ID information for identifying the calling station is telephone number information and the communication protocol executed corresponding to the telephone number is registered when the telephone number information designated upon an occasion of issuing a call is registered by the registration circuit (col. 15 line 4 through col. 17 line 2).

Regarding claim 4, Ueno teaches a data communication apparatus is capable of changing with different type of modems (figure 1 and col. 5 line 18 through col. 9 line 22).

Regarding claim 5, Ueno teaches the facsimile protocol including V.21 and V.29 (figure 1). Ueno differs from the claimed invention in not including V.8 and V.34, the particular of

protocol used is merely a matter of design option such that V.34 is the international standard for dial up modems of up to 28,800 bits per second and V.8 is a way V.34 modems negotiate connection features and option. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ueno using V.8 and V.34 in the communication apparatus because it makes compatible with different protocols so that it can be widely used to communicate with other apparatus in different protocols.

Regarding claim 6, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 11, Ueno discloses a communication apparatus having a plurality of modems comprising receiving means for receiving ID information at a calling station before a start of communication of protocol signal relating to image communication on the occasion of reception a call (col. 5 lines 6-17), control means for conducting communication because on an image communication protocol corresponding to the ID information received by the receiving means (col. 5 lines 43-57). Ueno differs from the claimed invention in not specifically teaching the receive circuit for receiving ID of the calling station on the occasion of reception of the call and the control circuit adapted to conduct communication base on image communication protocol to the ID information received by the receiver circuit or to conduct communication to determine an image communication protocol to be used according to whether or not the ID information is received by the receiver circuit. However, Kinoshita teaches a communication terminal apparatus capable of automatically selecting different communication protocols in correspondence with a caller identification information in order to make more flexible and efficient utilization of the communication terminal apparatus (col. 14 line 45 through col. 17 line

16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ueno in receiving the ID information of the calling station so that the control circuit adapted to start the facsimile protocol corresponding to the ID information detected by the detector circuit is stored in the memory, as per teaching of Kinoshita, because it makes more flexible and efficient utilization of the communication terminal apparatus.

Regarding claim 12, Kinoshita discloses the ID information is received between receiving successive calling signal (col. 14 lines 52-61).

Regarding claim 13, Kinoshita teaches a memory for storing a communication protocol that the respective calling stations can utilize, wherein the control circuit selects at least one protocol based on the ID information received by the receiver circuit and ID information stored in the memory (col. 14 lines 1-44).

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claims 2-3.

Regarding claim 18, the limitations of the claim are rejected as the same reasons set forth in claim 11.

6. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueno (US PAT. 5,661,568) in view of Kinoshita et al. (US PAT. 5,216,517 hereinafter Kinoshita) as applied in claim 13 above and further in view of Kawaguchi (US PAT. 5,303,066).

Regarding claims 14-16, the combination of Ueno and Kinoshita differs from the claimed invention in not specifically teaching that an updating circuit to update the communication

protocols stored in the memory including a counter adapted to count a predetermined time of communication performed, wherein the updating circuit updates the respective communication protocol for each communication apparatus when the counter has counted the predetermined time. However, Kawaguchi teaches means for updating a management table, i.e., updating circuit, capable of updating the respective communication protocol for each communication apparatus based on history updated information (col. 14 lines 6-66). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Ueno and Kinoshita in having the updating circuit, as per teaching of Kawaguchi, in order to determine an optimum protocol to be used for a communication between the transmitting unit and the receiving unit based on history updated information.

Response to Arguments

7. Applicant's arguments filed 10/3/2003 (paper no. 50) have been fully considered but they are not persuasive.

In response to applicant's argument that the combination of Ueno and Kinoshita fails to teach a communication apparatus adapted to execute a plurality of kinds of facsimile protocols of which image transmission speeds are different from each other, wherein the apparatus includes a detector circuit adapted to detect ID information for identifying calling station before a start of communication with the calling station, on an occasion of reception of call, a communication circuit adapted to communicate with the calling station using one of the plurality of kinds of facsimile protocols, a memory adapted to store ID information detected by the detector circuit and a facsimile protocol used for communication with the calling station conducted through the

communication circuit in correspondence with each other, and a control circuit adapted to cause communication to be conducted using a facsimile protocol stored in the memory in correspondence with the detected ID information when ID information detected by the detector circuit upon an occasion of reception of a call is already stored in the memory, it appears that Ueno clearly teaches a data communication apparatus for sending communication protocol signals and data having different data transmission speed, i.e., using a low speed modem and a high speed modem (abstract), a detection circuit within NCU (110, figure 1) for detecting ID information for identifying calling station before a start of communication with the calling station (col. 4 lines 50-57), a memory (105, figure 1) for storing communication information (col. 5 lines 6-17), a control circuit (104, figure 1) for causing communication to conducted using a specific communication protocol stored in the memory in the memory in correspondence with the detected ID signal (col. 5 lines 30-57). Although Ueno does not specifically teach the detector circuit to detect ID information for identifying the calling station on before the start of communication with the calling station an occasion of reception of a call so that the control circuit is adapted to cause communication to be conducted using a facsimile protocol stored in the memory in correspondence with the detected ID information when ID information upon the occasion of reception of the call is already stored in the memory, Kinoshita teaches a communication terminal apparatus for receiving an incoming call signal and detecting the presence of the incoming signal (col. 14 line 45 through col. 15 line 31) in order to automatically cause communication to be conducted using a predetermined transmission control procedure, i.e., a specific communication protocol, in correspondence with the detected ID information (col. 16 line 17 through col. 17 line 16), thereby it recognizes Kinoshita teaching to detect ID

information of a calling station upon reception of a call to control which of a plurality of kinds of communication protocols to use for the call based on information stored in a memory. Thus, the combination of the Ueno and Kinoshita teaches the claimed limitations.

In response to applicant's argument that the implementation of communication protocol of Ueno based on a determination made at the calling side and the implementation of communication protocol of Kinoshita based on a determination made at the called side, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Ueno merely is used for shown the backbone structure of a data communication apparatus having a detection circuit, a communication circuit, a memory and a control circuit. Although Ueno teaches to check whether an abbreviated protocol is to be used at the calling side when a call is to be made, it recognizes the communication apparatus of Ueno is capable of receiving a call from a remote communication apparatus. Note while Kinoshita teaches a technique of operating the communication apparatus to automatically select different communication protocols in correspondence with the ID information of the calling station in order to make more flexible and efficient utilization of the communication apparatus, and Kinoshita clearly discloses the communication apparatus performing communication based on information received at the called side (col. 14 line 45 through col. 17 line 16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ueno in using the

technique of operating the communication apparatus to receive the call as taught by Kinoshita in order to make more flexible and efficient utilization of the communication apparatus, thereby the combination of Ueno and Kinoshita teaches a feature of conducting communication according to whether ID information of the calling station is received on the occasion of reception of a call.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

8. Any response to this action should be mailed to:

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or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

George Eng

GEORGE ENG
Art Unit 2643